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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,345	07/28/2003	Philip S. Green	00287S-004450US	6351
20350	7590	10/28/2004	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			PRIDDY, MICHAEL B	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/629,345	Applicant(s) GREEN ET AL.	
	Examiner Michael B Priddy	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 13-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Priority

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37-CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: claim 21 requires the manipulator system comprise one or more electrical feed-throughs. No reference to this terminology was found in the specification.

Claim Objections

Claims 17-20 are objected to because of the following informalities: in line 3 of claim 17, "the surgical instrument assembly" should be –the surgical

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instrument; in line 2 of claim 19, "actuatoable" should be –actuatable--; and in line 1 of claim 20, "the drive assembly" should be –the actuator drive--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 13-16 and 19-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Green (U.S. 5,808,665). Green teaches a surgical instrument manipulator system comprising: a manipulator assembly 24; a sterilizable surgical instrument coupleable to the manipulator assembly 24, the surgical instrument comprising an elongate member with a proximal end, a distal end a longitudinal centerline therebetween and an end effector 170 coupled to the distal end; and a sterilizable instrument support sleeve 180 coupleable to the manipulator assembly 24, the sleeve 180 configured to be insertable through a percutaneous incision in the body of a patient during an endoscopic surgical

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procedure, the sleeve 180 comprising an axial passage for supporting and receiving the surgical instrument therethrough so that the end effector 170 is disposed adjacent a target site within the body, wherein the manipulator assembly 24 comprises an actuator drive 140/142 for manipulating the surgical instrument therewith, the actuator drive configured to engage the surgical instrument so as to transfer at least two motion actuations from the actuator drive to the surgical instrument; wherein the elongate member of the surgical instrument rotatably engages the axial passage of the support sleeve, and wherein the at least two motion actuations include rotating the elongate member with respect to the passage; wherein the end effector 170 is coupled to the distal end of the elongate member of the surgical instrument by an actuatable wrist 172 member having a wrist axis, wherein the at least two motion actuations include rotating the wrist member 172 about the wrist axis to provide at least one degree of freedom of the end effector 170 relative to the elongate member 160; wherein the end effector 170 is movably actuatable and wherein the motion actuations include rotation of the surgical instrument about the longitudinal centerline of the elongate member and actuation of the end effector 170; wherein the drive assembly includes a first controllable motor 140 for rotating the surgical instrument about the instrument centerline, a second controllable motor 182 for actuating the end effector on the surgical instrument and a third controllable motor 186 for axially translating the surgical instrument relative to the manipulator assembly 24; further comprising an input control device 20 located remotely from the manipulator assembly 24 and coupled to a servomechanism of

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the manipulator assembly 24 so as to permit an operator to remotely control the surgical instrument with the input control device 20; further comprising a plurality of different surgical instruments, the surgical instruments sequentially coupleable to the manipulator assembly 24 so that different surgical instruments may be used during an endoscopic procedure; wherein the manipulator system further comprises one or more electrical feed-throughs for transferring electrical signals to and/or from the manipulator assembly and the surgical instrument.

Claims 13, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Green. Green teaches a surgical instrument manipulator system comprising: a manipulator assembly 24; a sterilizable surgical instrument 260 coupleable to the manipulator assembly 24, the surgical instrument 260 comprising an elongate member with a proximal end, a distal end a longitudinal centerline therebetween and an end effector 270R/L coupled to the distal end; and a sterilizable instrument support sleeve 180 coupleable to the manipulator assembly 24, the sleeve configured 180 to be insertable through a percutaneous incision in the body of a patient during an endoscopic surgical procedure, the sleeve 180 comprising an axial passage for supporting and receiving the surgical instrument 260 therethrough so that the end effector 270R/L is disposed adjacent a target site within the body, wherein the manipulator assembly 24 comprises an actuator drive 140/142 for manipulating the surgical instrument 260 therewith, the actuator drive 140/142 configured to engage the surgical instrument 260 so as to transfer at least two motion actuations from the actuator drive to the surgical instrument; wherein the end effector 270R/L is coupled to the distal end of the

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elongate member of the surgical instrument by a steerable, bendable member 268R/L, the surgical instrument assembly further comprising at least one control element releasably coupling the bendable member to the actuator drive of the manipulator assembly, wherein the at least two motion actuations include steering the bendable member to provide at least one degree of freedom of the end effector relative to the elongate member; wherein the at least one control element comprises a plurality of cables.

Conclusion

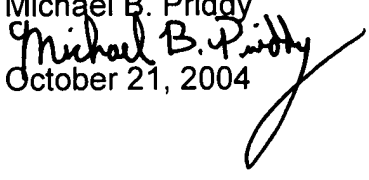
Any inquiry concerning this communication from the examiner should be directed to Michael B. Priddy whose telephone number is (703) 308-8620. The examiner can normally be reached on Mon.-Fri. 8 a.m. - 5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael B. Priddy


October 21, 2004